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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,484	09/07/2001	Wen-Sung Tsai	CEIP0027USA	4155

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NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION  
P.O. BOX 506  
MERRIFIELD, VA 22116

EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/682,484

Applicant(s)

TSAI, WEN-SUNG

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to the following communication: RCE filed 09/30/2005 to the original application filed 09/07/2001.
2. Claims 1-19 are currently pending in this application. Claims 1-6, 9-13, and 15-16 have been amended. Claims 18-19 have been added. Claims 1, 10, and 18 are independent claims

***Request Continuation for Examination***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/30/2005 has been entered.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 1-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant **Admitted Prior Art** (APA) in view of **Horie et al.** (U.S. 6,487,597 filed 08/1999).

**As to claim 1**

- a. APA teaches (*Fig.1*) a personal data assistant (*PDA 10; para.0006*) connected to a server (*the computer 40; para.0007*), the server having a plurality of application programs (*the computer 40 comprises a plurality of application program 44; para.0007*) the PDA comprising:
- (i) a housing (*a housing; para.0006*);
  - (ii) a memory installed in the housing for storing programs and data (*a memory 14 for storing application programs 16 and files 18; para.0007*);
  - (iii) a processor electrically connected to the memory for executing the programs stored in the memory (*a processor 20 electronically connected to the memory 14 for executing the application programs 16; para.0007*);
  - (iv) a display panel installed on the housing for displaying data (*a display panel 22 installed on the housing 12; para.0006*); and
  - (v) an input device for inputting data (*an input device 24; para.0006*);
- the server then opening the file using a corresponding application program (*e.g., the file is opened by a corresponding application program 44; para.0008*).

- b. APA does teach the PDA is capable of sending an original file through the wire 30, but does not explicitly teach “sending via network (e.g., Internet).” Also, APA does not explicitly teach “*sending images generated by the opened original file back to the PDA.*”
- c. Horie teaches sending via the network (*col.1, 62-67*) and sending images generated by the opening file back to the PDA (*col.6, line 66-col.7, line 35*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Horie in the system of APA because it would have provided the capability for transmitting data into a personal digital assistant in a simple operation such that a required portion of the data obtained by the information transmission can be utilized easily in the personal digital assistant.

**As to claim 2**

APA teaches a data transceiving module, the file being sent from the data transceiving module of the PDA to the data transceiving module of the server so that the server is capable of opening the original file (*para.0008*).

**As to claim 3**

APA teaches when the server opens the original file, the server will transmit the images generated by the opened original file via the data transceiving module of the server to the data transceiving module of the PDA so that the display panel is capable of displaying the opened original file (*para.0008*). Note the discussion of the claim 1 for “the display panel is capable of displaying the images generated by the opened original file.”

**As to claim 4**

APA teaches the server opens the original file, a user is capable of using the input device to enter a user instruction, the user instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so that the server is capable of executing the user instruction (*para.0008*). Note the discussion of the claim 1 for “the server transmitting new images generated by the opened original file generated by executing the user instruction to the data transceiving module of the PDA from the data transceiving module of the server so that the display panel is capable of displaying the new images generated by the opened original file.”

**As to claim 5**

APA teaches a user is capable of using the input device to enter a file back instruction, the file back instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server, when receiving the file back instruction, the server transmitting the original file back to the PDA via the data transceiving module of the server back and the data transceiving module of the PDA (*paras.0006 and 0008*).

**As to claim 6**

APA teaches a user is capable of using the input device to enter a file close instruction, the file close instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so as to make the server close the original file (*para.0006*).

**As to claims 7 and 17**

- a. Horie teaches the network is an Internet (*an Internet; col.4, lines 26-41*).

- b. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Horie in the system of APA because it would have provided the capability for transmitting data into a personal digital assistant in a simple operation such that a required portion of the data obtained by the information transmission can be utilized easily in the personal digital assistant.

**As to claim 9**

- a. Horie teaches by using the input device, the images generated by the opened original filed can be edited on the display panel (*col.10, lines 3-9*).
- b. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Horie in the system of APA because it would have provided the capability for improving the performance of a the PDA since it does not need to install a program in its memory for opening files.

**As to claim 10**

- a. The rejection of claim 1 above is incorporated herein in full. Additionally, APA further teaches:
  - (i) uploading an original file from PDA to the server (*upload the files to the PC; para.0005*);
  - (ii) the server opening the original file utilizing an appropriate application software stored on the server (*the user must open/edit the file by a corresponding application programs 44 in the computer 40*); and

- (iii) downloading the original file from the server to the PDA (*downloads the updated file from the computer 40 back to the PDA; para.0008*).
- b. APA, however, does not explicitly teach “*editing the original file on the display panel utilizing a user input device of the PDA.*”
- c. Horie teaches editing the file on the display panel utilizing a user input device comprised by the PDA (*col. 7, lines 34-63*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Horie in the system of APA because it would have provided the capability for transmitting data into a personal digital assistant in a simple operation such that a required portion of the data obtained by the information transmission can be utilized easily in the personal digital assistant.

**As to claims 11-13**

They include the same limitations as in claims 2-4, and are similarly rejected under the same rationale.

**As to claim 14**

APA teaches the user instruction is a file editing command (*para.0008*).

**As to claims 15-16**

They include the same limitations as in claims 5-6, and are similarly rejected under the same rationale.

**As to claim 18**

The rejection of claim 10 above is incorporated herein in full.



**As to claim 19**

Note the discussion of claim 10 above for rejection.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant **Admitted Prior Art (APA)** in view of Horie and further in view of **Jakobson** (U.S. 6,697,838 – filed 03/1998).

**As to claim 8**

- a. The combination of APA and Horie does not explicitly teach “the memory is a flash memory.”
- b. Jakobson teaches the memory is a flash memory (*flash memory; col.5, lines 50-56*).
- c. It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine Jakobson’s teachings in the system of APA as modified by Horie because it would have provided the capability for storing data, more particularly, for enabling the PDA to support new protocols as they become standardized.

***Response to Arguments***

7. Applicant’s arguments filed 09/30/2005 have been fully considered but they are not persuasive.

Applicant argues that *Neither the APA nor Mousseau teach the PDA sends an original file to the server and the server sends images of the original file back to the PDA* (Remarks, page 7).

In response, the combination of APA and the newly applied prior art (Horie) meets the limitations as claimed by Applicant. APA teaches sends an original file to the server (upload the files to the PC; para.0005); and Horie teaches the server sends images of the original file back to the PDA (transmit the new file to the PDA; col.7, lines 22-35).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suzuki et al.            U.S. Patent No. 6,493,473            issued: Dec. 10, 2002

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

*William G. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
*12/11/2005*